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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,618	10/17/2003	Masanori Shinozaki	12844.0048US01	2442
23552	7590	10/18/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,618

Applicant(s)

SHINOZAKI, MASANORI

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/15/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8, 10 and 12 is/are allowed.
- 6) ☒ Claim(s) 1-3, 9 and 11 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed on August 15, 2005 was received. Claims 1-5 are amended. Claims 9-14 are added.

2. Newly submitted Claims 13-14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The instant claims are directed to a manufacturing method for a lubricant, which is a method of making a lubricant that is in dried (solid) form, while the original claimed invention is directed to a liquid lubricant or a sliding member. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13-14 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Now, Claims 1-12 are pending for consideration.

3. In view of Applicants' amendment, claim rejection(s) under 35 USC 102/103 in paragraphs 5 and 10 of the previous Office Action (Paper No. 051405) is/are removed.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 051405).

Claim Rejections - 35 USC § 102 and 103

5. Rejection of Claim 1 under 35 USC 102(b) as being anticipated by JP757 (JP 11-207757) and rejection of Claims 2-3 under 35 USC 103(a) as being unpatentable over JP757 are maintained because the rejection is adequately set forth in paragraphs 3 and 7 of Paper No. 051405. Applicant's arguments have been fully considered but they are not persuasive. Furthermore, the newly added Claims 9 and 11 are rejected under 35 USC 102(b) as being anticipated by JP757 in the same ground. The focus argument related to the core patentability is discussed below.

For Applicants' arguments (Remarks, page 4, 4th paragraph), the mixture comprising particles of RBC dispersed in a liquid resin should inherently form a suspension. The liquid resin is a thermosetting resin, i.e., capable of drying. Because the resin is liquid, it should be capable of coating. As such, the suspension is certainly capable of forming a drying film by coating and drying thereof. Thus,

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whether the suspension being used for coating or not is irreverent and merely an intended use.

For Applicants' argument (Remarks, page 5, 5th paragraph), as mentioned above, the suspension is certainly capable of forming a drying film by coating and drying thereof. Whether the suspension being used for coating or not is irreverent and merely an intended use. Therefore, the film should be inherently capable of possessing the same properties as Applicants', e.g., lubrication, etc.

6. Rejection of Claim 1 under 35 USC 102(b) as being anticipated by JP389 (JP 03-060389) and rejection of Claims 2-3 under 35 USC 103(a) as being unpatentable over JP389 are maintained because the rejection is adequately set forth in paragraphs 4 and 8 of Paper No. 051405. Applicant's arguments have been fully considered but they are not persuasive. Furthermore, the newly added Claims 9 and 11 are rejected under 35 USC 102(b) as being anticipated by JP389 in the same ground. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 4, last paragraph), the mixture comprising particles of RBC dispersed in a liquid resin (before drying the liquid resin) should inherently form a suspension. The liquid resin is a thermosetting

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resin, i.e., capable of drying. Because the resin is liquid, it should be capable of coating. As such, the suspension is certainly capable of forming a drying film by coating and drying thereof. Thus, whether the suspension being used for coating or not is irreverent and merely an intended use.

For Applicants' argument (Remarks, page 5, last paragraph to page 6, 1st paragraph), as mentioned above, the suspension is certainly capable of forming a drying film by coating and drying thereof. Whether the suspension being used for coating or not is irreverent and merely an intended use.

Therefore, the film should be inherently capable of possessing the same properties as Applicants', e.g., lubrication, etc.

7. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of JP757, JP389 and Shinozaki (JP 2002-030222) teaches or fairly suggests the use of an acrylsilicone resin.

Allowable Subject Matter

8. Claims 5-8, 10 and 12 are allowed.

9. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest references:

None of JP757 and JP389 teaches or fairly suggests a sliding member.

Shinozaki (JP 2002-030222) does not teach or fairly suggest a sliding member having a sliding surface covered with a dry film set forth in the instant claims. Furthermore, Shinozaki's thermoplastic resins are not liquid as indicated in [0018]. For example, the mixture of the polyacetal and the powder of carbonaceous material is in a form of rod. [0031].

10. The references cited in information disclosure statement filed on August 15, 2005 have been lined through because they have been cited in the prior information disclosure statement. However, the English translations thereof filed by Applicants have been fully considered.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an

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application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

October 14, 2004



Kuo-Liang Peng
Primary Examiner
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